

REMARKS

This Amendment is in response to the Office Action mailed March 3, 2009. In view of the amendments and arguments contained herein which are believed to put the subject case in condition for allowance, reconsideration of the subject objections and rejections is hereby respectfully requested.

I. Objections to the Drawings Under 37 C.F.R. §1.83(a)

The Examiner has objected to the drawings for failing to illustrate all of the features of claims 5 and 6. Although Applicant reserves the right to present the subject matter of such claims (as well as make necessary drawing corrections, if any) for examination at a later date (in this application or a divisional or other related application), Applicant has simply canceled claims 5 and 6 to comply with the requirements of the Office Action. Withdrawal of the subject objections is therefore respectfully requested.

II. Objections Relating to Informalities in the Specification and Claims

The Office Action objects to the specification and claims for containing several misspellings. In response to these objections, Applicant has complied with the Examiner's helpful suggestions and amended the application as follows:

- The specification has been amended to correct the spelling of "undesirable"; and
- The claims have been amended to correct the spelling of "fluid-tight".

In light of the spelling corrections made to the specification and claims, withdrawal of the subject objections is respectfully requested.

III. Claim Rejections Under 35 U.S.C. §112

Claims 1-12 have been rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject invention. In response to these rejections, Applicant has:

- Amended claims 1 and 7 to delete the limitation "in particular, tyres";
- Amended claim 4 (by rewriting it as new claim 14) and claim 9 to delete the limitation "or vice versa".
- Amended the dependency of claim 9 so that it depends from claim 14 (originally claim 4) so that there is sufficient antecedent basis for the term "said rod";
- Amended the dependency of claim 10 so that it depends from claim 7 so that there is sufficient antecedent basis for the term "a kit";

In view of the above amendments to the claims, withdrawal of the rejections under 35 U.S.C. §112 is hereby respectfully requested.

IV. Claims Reciting Allowable Subject Matter

Applicant extends his gratitude to the Examiner for his indication that claims 3 and 4 recite patentable subject matter and would be allowable if re-written to be in independent form. In response, Applicant has re-written such claims as new claims 13 and 14 principally to accept the Examiner's indication of the recitation of allowable subject matter while simultaneously seeking to avoid the negative implications of prosecution history estoppel (e.g., due to any arguments presented regarding claim 1).

Moreover, for reasons related to antecedent basis (described above), claim 9 has been amended to depend from claim 14 (old claim 4). As such, claim 9 should now be allowable, and a holding to this effect is respectfully requested.

V. Claim Rejections Under 35 U.S.C. §103

Claims 1-12 have been rejected as reciting subject matter obvious over Eriksen alone or in view of Scott (claims 5-6 having been herein cancelled). Reconsideration of these rejections is hereby respectfully requested.

A. ARGUMENT INTRODUCTION

According to the subject Office Action, the Eriksen reference teaches all limitations recited in claim 1 except for the recitation that the "closing means is integrated in said container and housed into said opening". Based upon this conclusion, the Examiner has rejected claim 1 based on the supposition that "reversal of the essential working parts of a device involves only routine skill in the art" (relying on In re Einstein).

As a first matter, however, claim 1 recites several important structural differences as compared to the Eriksen reference other than the one noted by the Examiner. Moreover, in the subject Office rejection, the difference between claim 1 and Eriksen which has been acknowledged by the Examiner has been mischaracterized. Importantly, such (acknowledged) difference does not consist merely of "reversals of the essential working parts". Also instructive, if the Eriksen reference were modified in the manner suggested by the Examiner, the Eriksen apparatus would be rendered inoperable.

For at least each of these reasons (discussed in more detail

below), the Examiner's rejection of claim 1 (and all of its dependent claims) is believed to be erroneous and is requested to be withdrawn.

B. THE DIFFERENCES BETWEEN THE STRUCTURE RECITED IN CLAIM 1
AND THE ERIKSEN REFERENCE ESTABLISH PATENTABILITY

In order to sustain an obviousness rejection, MPEP §2143.03 requires that "[a]ll words in a claim must be considered". To render claim 1 unpatentable, however, the Office must do more than merely "consider" each and every feature of the claims. Instead, the relied upon prior art must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art); *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988) ("Both the suggestion and the expectation of success *must be founded in the prior art, not in the applicant's disclosures*. . . . There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure.") (emphasis added) (citation omitted). Indeed, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-KSR obviousness rejection still requires the Examiner to "make a 'searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.' . . . Thus, 'obviousness requires a suggestion of all limitations in a claim.'" *In re Wada and Murphy*, Appeal 2007-3733, *7, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) and *CFMT v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (emphasis in original). In short, it remains settled law that an obviousness rejection

requires a suggestion or teaching in the prior art of all the claim elements.

Given this state of the law, and principally because independent claim 1 expressly recites several features nowhere taught by the record prior art (contrary to the Examiner's contentions that there is only one difference), the Examiner's rejection of claim 1 (and therefore its dependent claims) cannot be maintained. In this regard, the Eriksen reference relied upon by the Examiner differs from the apparatus claimed in claim 1 in several important respects. Although the Eriksen device does dispense a sealing fluid from a bottle or reservoir, the fluid reservoir in Eriksen is sealed or closed in the reservoir via a membrane closure which is punctured when it is desired to dispense the sealing fluid (i.e., see membrane 38 in Fig. 10 of Eriksen). Such membrane is affixed to the mouth of the fluid container 3 where the container is attached to a series of additional parts, including a rotating manifold which carries a piston with a sharpened tip. Notably as well, there are no parts - including even the membrane closing device itself - which are located or integrated within the liquid container itself.

Conversely, claim 1 of the present application recites an apparatus which includes a "closing means" comprising "a valve device integrated in said [sealant] container" with the valve device having an "inlet connectable to a compressed-air feed line" and "an outlet for dispensing the sealing liquid". The "valve device" (i.e., the closing device) is also recited as including at least one moveable "control member, moveable" into open and closed positions e.g., for containing sealant within the container or for effectively opening the container to allow sealing liquid to be dispensed.

As can be seen, although the Office Action equates the

closing means of claim 1 with the closing device of the Eriksen reference (while only acknowledging differences in their location), the closing membrane disclosed in the Eriksen reference and the "closing means" (i.e., "valve device") claimed in claim 1 are entirely dissimilar structures (the claimed "closing means" structure being an openable and closeable device having moveable parts, inlets and outlets, etc. and the Eriksen closing structure being a mere membrane). Therefore, the Office rejection is in error in describing the differences between the invention as claimed and the prior art as one of mere location of the "closing means" (see OA page 5). That is, there are many important structural differences. This, by itself, requires removal of the current rejections.

C. THE ACTION'S RELIANCE ON *IN RE EINSTEIN* IS IN ERROR;
MODIFYING THE REFERENCE ACCORDING TO THE EXAMINER'S
SUGGESTIONS WOULD NOT RESULT IN THE STRUCTURE CLAIMED IN
CLAIM 1

Although the Office Action principally relies on In re Einstein for the proposition that if an invention can be obtained by "mere reversal of parts", then such invention is obvious, such reliance is in error for several reasons.

First, modern Federal Circuit case law contradicts In re Einstein and is controlling. Although modern law requires some motivation or suggestion for modifying a reference to sustain a §103 rejection ("(Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.)." *In re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995) (citation omitted)), the Examiner has not even attempted to explain such motivation or its origin (and such reasoning or motivation is not contained in Eriksen itself).

This, under recent Supreme Court case law, is fatal to the present rejection. ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added))).

Second, and just as fatal to the rejection, modifying the Eriksen reference in accordance with the Examiner's suggestions would not arrive at Applicant's claimed invention. Specifically, moving Eriksen's closing membrane into the interior of the sealant container (itself not a reversal of parts as suggested by the Office Action, therefore, incidentally, rendering *In re Einstein* inapplicable even though otherwise obsolete) would not transform the puncture-able membrane into a openable and closable valve structure (with the many other claimed structural features), nor would it give the Eriksen device the same functionality (by way of claimed structural features) as Applicant's claimed repair/inflation apparatus.

In this regard, Applicant's claimed structure allows the entire container and valve assembly to be removed from the rest of the claimed device as a single unit so that it can be replaced with a similar replacement unit in one simple operation (in order to reuse Applicant's claimed sealing apparatus). Contrarily, in order to reuse the device described in Eriksen, container 3 must be removed as well as parts 49, 16, 54, and 27 - in independent disassembly steps - such as shown in Fig. 10 of Eriksen, for example. Afterwards, identical replacement parts must be reassembled to the Eriksen device, also in individual or separate steps. This, of course, takes more time and skill, including certain levels of manual dexterity to make the

appropriate assembly (as compared to the structure of the device as claimed), which is not desirable in devices intended to be sold to the public at large.

Similarly, Eriksen's rotating manifold structure could not be successfully modified (e.g., even by reversal of parts), absent reliance on the teachings of Applicant's own disclosure (which, of course, is impermissible; see *In re Kubin*, 561 F.3d 1351, 1359 (Fed. Cir. 2009) ("[C]ourts should not succumb to hindsight claims of obviousness."¹), and without significantly reengineering the Eriksen' structure in many ways nowhere disclosed or suggested in the prior art.

For example, even if one somehow resized and reshaped the relevant parts of Eriksen so that they would fit inside the sealant container (even though no motivation for doing so has been explained or provided), this would render the device inoperable. That is, the closing (sealing) membrane would be useless regardless of its position within the container (located on one side of the manifold, it would not allow access for pressurizing tubing, and located on the other side, it would not provide any seal). Without the sealing membrane, however, Eriksen will not function as intended (e.g., sealant could not be securely retained in the container). Such reference therefore effectively teaches away from the claimed invention (at least as modified by the Examiner) and thus cannot be relied upon to support a proper §103 rejection. See *In re Gordon*, 733 F.2d 900,

¹See also *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) ("The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.")

902, 221 USPQ 1125, 1127 (Fed.Cir.1984) (inoperable modification teaches away); *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness."); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244, 56 C.C.P.A. 823 (1969) (references teach away from combination if combination produces seemingly inoperative device).

D. SUMMARY

In sum, because there is no articulated, rational reasoning to support the Examiner's rejection of claim 1 ("*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l*, 127 S. Ct. at 1741), and, moreover, because the failure of the prior art to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103 (*In re Wada and Murphy*, Appeal 2007-3733, *7), the Examiner's rejections of claim 1 and its dependent claims are improper and should be withdrawn.

VI. Conclusion

In view of the above amendments and arguments, all pending claims are believed to recite patentable subject matter and an allowance of such claims is therefore respectfully requested.

Although all issues pertaining to patentability are believed to be resolved by this Amendment, if this determination is incorrect, the Examiner is invited to contact the undersigned telephonically so that any remaining issues may be resolved most expeditiously.

Respectfully submitted,

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Enclosure(s)